The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARY D. PERTTUNEN

MAILED
JAN 31 2006
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2005-1633
Application No. 09/629,013

ON BRIEF

Before GROSS, BLANKENSHIP, and NAPPI, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 10-14, 16-27, 29-37, and 39-44.

We reverse.

BACKGROUND

The invention is directed to a method for relating advertiser-usable variables with particular hyperlinks returned in Internet searches. Claim 36 is reproduced below.

36. A method comprising:

targeting an advertisement to a particular numerical range of one or more positions in browsing sequences of Web resources;

receiving, from a client node, a user selection of a hyperlink to a Web resource having a browsing sequence position within the particular numerical range associated with the advertisement;

selecting the advertisement to display with the Web resource based on said targeting and the browsing sequence position of the Web resource;

providing the advertisement to the client node; and

displaying, by the client node, the advertisement with the Web resource.

The examiner relies on the following references:

Merriman et al. (Merriman)	5,948,061	Sep. 7, 1999 (filed Oct. 29, 1996)
Culliss	6,078,916	Jun. 20, 2000 (filed Mar. 12, 1998)
Davis et al. (Davis)	US 6,269,361 B1	Jul. 31, 2001 (filed May 28, 1999)
Cohn et al. (Cohn)	US 6,308,202 B1	Oct. 23, 2001 (filed Sep. 8, 1998)

"Netscape's Communicator third party cookie option foiled" (cookiecentral), available at http://www.cookiecentral.com/dsc3.htm (Jun. 22, 2005).[1]

Claims 10-12, 14, 16-25, 27, 29-36, and 39-41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cullis and Cohn.

Claims 13 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cullis, Cohn, and Merriman.

Claim 37 stands rejected under 35 U.S.C. § 103 as being unpatentable over Cullis, Cohn, and Davis.

Claims 42-44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cullis, Cohn, and cookiecentral.

The examiner has withdrawn a rejection of claims 36, 37, and 39-41 under 35 U.S.C. § 102 as being anticipated by Cullis.

Claims 1-9 and 38 have been canceled. Claims 15, 28, and 45 have been withdrawn from consideration.

We refer to the Final Rejection (mailed Aug. 9, 2004) and the Examiner's Answer (mailed Dec. 29, 2004) for a statement of the examiner's position and to the Brief (filed Oct. 13, 2004) and the Reply Brief (filed Jan. 12, 2005) for appellant's position with respect to the claims which stand rejected.

[1] According to the Examiner's Answer, the article was cached by www.archive.org on Dec. 11, 1997.

OPINION

At the outset, we note that the scanned copy of the instant specification in the USPTO image file wrapper is replete with underlining and extraneous marks that were apparently reproduced from the paper file wrapper. To avoid errors in the text of any patent that may issue from the instant application, we recommend (but do not require) that appellant file a substitute specification. See 37 CFR § 1.125; Manual of Patent Examining Procedure § 608.01(q).

The statement of the rejection of instant, independent claim 10 (Answer at 3-4) does not relate all limitations of the claim to the teachings of the references. However, the rejection concludes that it would have been obvious to have included advertising with the system of Cullis, as Cohn "teaches the idea of showing ads based upon the selected link URL." (Id. at 4) The rejection thus appears to hold that Cullis teaches all the limitations of claim 10, except for the inclusion of "advertising."

We agree with appellant, for substantially the reasons expressed in the Brief, that the examiner has failed to set forth a prima facie case for obviousness with respect to the subject matter as a whole of claim 10. We do not find the various teachings in Cullis that are implied by the rejection. For example, the rejection submits that Cullis teaches that "search activity history can be stored as cookies," referring to column 29, lines 22 through 30 of the reference. (Answer at 3.) Cullis teaches in the relevant section that "cookies" may contain key terms and/or key term groupings and scores for certain articles as a result of a user's search activity. The cookies could be periodically

downloaded to a central location, where the data may be used in organizing the articles for future searches. The section does not describe, however, storing the "specific link information" in the cookies. Even assuming that such is "inherently" required, as alleged by the rejection, the teaching is not commensurate with the claim 10 requirement of "storing the first advertiser-usable variable and the second advertiser-usable variable in at least one cookie. . . ." In particular, we find no suggestion for storing advertiser-usable variables, as claimed, as part of the search activity history as taught by Cullis. In our view, such a combination could only result from an improper hindsight reconstruction of the invention.

Independent claim 23 contains limitations similar to those of claim 10. Claim 23 requires, however, storage of the advertiser-usable variables in a database of an advertisement server node. The statement of the rejection of claim 23 (Answer at 4) rests on the finding of a suggestion for (first) storing the variables in cookies at the client node, which is a finding that is unsupported by the applied references.

The additional references applied against dependent claims 13, 26, and 42 through 44 do not remedy the deficiencies in the rejection against base claims 10 and 23. We thus do not sustain the § 103 rejection of claims 10-14, 16-27, 29-35, and 42-44.

Instant claim 36 recites, "targeting an advertisement to a particular numerical range of one or more positions in browsing sequences of Web resources. . . ." We note that a "browsing sequence" of Web resources, in view of pages 9, 18, and 19 of the

specification, may be defined by a unary tree (wherein each internal node of the tree has one child). Each of the Web resources is represented by a corresponding node of the tree. The level number of a node is defined as the number of edges in the path between the node and the root node. However, as the examiner indicates, the language of claim 36 does not limit the "particular numerical range" to a range of level numbers.

Appellant submits that claim 36 distinguishes over the applied Cullis and Cohn references. In particular, appellant argues that Cohn teaches targeting advertisements to particular URL categories.

> The rejection of claims 36 and 39-41 is based on the Examiner stating that ads targeted to ordered URLs are taken to be targeted to the ordered positioning within the list. Applicant disagrees with this interpretation. Cohn et al. discloses targeting an ad to a category of content, and transmitting the ad if content from a URL is within the category. Thus, regardless of the ordering of the URLs in Culliss, Cohn et al. would provide the same content-based advertising for each URL based on each URL's content.

(Brief at 24.)

The examiner responds:

> Regarding claim 36, ads targeted to ordered links/URLs are taken to be targeted to the ordered positioning where they reside within the list. Applicant's statement that the applied art would result in the same advertising if a URL was to change positions is narrower than the current claim scope. There are no limitations claimed regarding how ad content would or would not change if the URL positioning were to change.

(Answer at 8.)

Cohn teaches an improvement over targeting advertising to keyword searches (col. 2, ll. 28-51) as taught by Cullis (col. 17, l. 42 - col. 18, l. 6). In the Cohn system, advertisements are targeted to particular categories (e.g., sports, news, art, history, finance; col. 4, ll. 52-54). The system determines if a particular URL is within a predefined category by, for example, searching a category database for the category of URL. Col. 7, l. 3 - col. 8, l. 10; Fig. 4. Cohn thus may be deemed to teach that which the rejection relies on Cohn as teaching -- i.e., the reference teaches "the idea of showing ads based upon the selected link URL." (Answer at 4.) However, we agree with appellant that the combined teachings of Cullis and Cohn would have suggested, at best, that the advertising to be selected for each URL be based on the URL's content. The targeting of an advertisement would be based on category of URL, rather than a particular numerical range of one or more positions in browsing sequences of Web resources as claimed. Further, we have no explanation as to how the Cullis teaching that system scoring is based upon the relative positioning of the links within the list or tree (Answer at 4) might be deemed to teach or suggest targeting an advertisement as claimed.

We therefore do not sustain the rejection of claim 36, nor of depending claims 39 through 41. We do not sustain the rejection of claim 37, as Davis does not remedy the deficiencies in the rejection applied against base claim 36.

CONCLUSION

The rejection of claims 10-14, 16-27, 29-37, and 39-44 under 35 U.S.C. § 103 is reversed.

REVERSED

ANITA PELLMAN GROSS
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

ROBERT E. NAPPI
Administrative Patent Judge

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